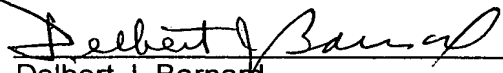




PATENT APPLICATION

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Delbert J. Barnard
Registration No. 20,515

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Art Unit: 3712
Examiner: Urszula M. Cegielnik
Applicant: Brett J. Diffley
Ser. No.: 10/687,778
Filed: October 16, 2003
For: FLOATING WATER TOY
Date: November 17, 2004

RESPONSE

No Fee
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

This is in response to the Office Action dated July 14, 2004, relating to the above-identified application.

Claims 1 and 9 have been rejected under 35 U.S.C. § 102(b) as being anticipated by U.S. Patent No. 6,415,451 B1, granted July 9, 2002 (hereinafter Waller 6,415,451). The remaining claims 2 – 8 and 10 have been objected to as

being dependant upon a rejected base claim. The Examiner states that they would be allowable if rewritten into independent form.

Applicant respectfully disagrees with the rejection of claims 1 and 9 as being anticipated by Waller 6,415,451. It is very settled law, anticipation can only be established by a single prior art reference which discloses each and every element of the claimed invention. See for example, *Structural Rubber Products Co. v. Part Rubber Co.*, 749 F2d 707, 223 USPQ 1264 (Fed. Cir. 1984) in which the court stated:

This court has repeatedly stated that the defense of lack of novelty (i.e., "anticipation") can only be established by a single prior art reference which discloses each and every element of the claimed invention. *RCA Corp v. Applied Digital Data Systems, Inc.*, 730 F2d 1440, 1444, 221 USPQ 385, 388 (Fed. Cir. 1984); *Radio Steel & Mfg. Co. v. MTD Products, Inc.*, 731 F2d 840, 845, 221 USPQ 657, 661 (Fed. Cir. 1984); *Connell v. Sears, Roebuck & Co.*, 722 F2d 1542, 1548, 220 USPQ 193, 198 (Fed. Cir. 1983); *Kalman v. Kimberly-Clark Corp.*, 713 F2d 760, 772, 218 USPQ 781, 789 (Fed. Cir. 1983); *SSIH Equipment, S.A. v. U.S. Int'l Trade Comm'n.*, 718 F2d 365, 377, 218 USPQ 678, 688 (Fed. Cir. 1983).

The statutory language mandates such an approach. Section 102 speaks in terms of *the invention* having been known or used by others, or patented or described in a printed publication.

Claim 1 specifies "a buoyant body having a lower portion adapted to float on a body of water, and an upper portion connected to the lower portion and extending upwardly from it." In the rejection, the Examiner states that Waller 6,415,451 "discloses a water toy comprising a buoyant body (12) having a lower portion (the lower portion of reference 12) adapted to float on a body of water." Waller 6,415,451 states that the squirting swim mask 10 is provided as a toy that combines the functions of a snorkel mask 12 with that of a squirt gun. "The outward appearance of the invention is that of a conventional snorkeling mask 12." See column 2, lines 55 – 57. It is well known, a conventional snorkeling mask does not float. It does not

include "a buoyant body having a lower portion adapted to float on a body of water." The Examiner has not pointed to any part of the disclosure Waller 6,415,451 that would support the conclusion that the patent discloses "a buoyant body with a lower portion adapted to float on a body of water."

Claim 1 next specifies that the "buoyant body" has "an upper portion connected to the lower portion and extending upwardly from it." In the rejection, the Examiner states that "the upper portion of reference 12" is the "the upper portion" that is claimed. However, claim 1 specifies that the "upper portion" includes "top and side walls forming an inner cavity--- sufficiently large to receive the head of a person." In Waller 6,415,451, the mask that is enclosed shows a region behind a lens that receives a portion of a person's face. This region is formed by both the upper and lower portions of the mask. The mask most certainly does not include "an inner cavity" that is "sufficiently large to receive the head of a person."

In the claimed water toy, the lower portion of the buoyant body floats on the water. The upper portion of the buoyant body projects upwardly from the lower portion and includes an inner cavity in which the head of a person is received. The person extends his or her head upwardly through a bottom opening in the lower portion of the buoyant body and into the inner cavity in the upper portion of the buoyant body. This is what is claimed but it is not what is disclosed by Waller 6,415,451.

Claim 9 depends from claim 1 and adds the feature of a first water gun situated in a second opening and a second water gun situated in a third opening. The claim states that the first water gun includes a "discharging portion above the lower portion of the buoyant body" and the second water gun includes a "discharging

portion above the lower portion of the buoyant body." This is quite clearly not disclosed by Waller 6,415,451. The body 12 is not a "buoyant body." The nozzles 15 are not positioned above the lower portion of a buoyant body. There is absolutely no disclosure in Waller 6,415,451 that the portion of mask 12 below the nozzles 15 is "buoyant."

In summary, for the reasons discussed above, Waller 6,415,451 is not "a single prior art reference which discloses each and every element of the claimed invention." For that reason, claims 1 and 9 are not anticipated by the patent.

It is submitted that all of the claims in this application are allowable. Earlier reconsideration and allowance of the application are requested.

Respectively submitted,

Brett J. Diffley

By: 

Delbert J. Barnard
Attorney for Applicant
Registration No. 20,515
(206) 381-3100

DJB/kb